

## R E M A R K S

Prior to entry of this Amendment:

- Claims **1-162** were pending in the present application
- Claims **1-162** stand rejected

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims **139-300** will be pending (162 total claims)
- Claims 1-138 will be cancelled
- Claims **163-300** will be added
- Claims **139-163, 249, 250, 253, 256, 259, 277, 278, 283, 286-291, 295 and 300** will be the only independent claims (41 independent claims)

### **A. Claim Amendments**

#### **1. Claims 1-138 have been canceled**

Claims 1-138 have been canceled without prejudice. We submit that all of Claims 1-138 contain allowable subject matter and are statutory. We do not, however, wish to incur any additional cost and delay in appealing the Examiner's Section 103 and Section 101 rejections of Claims 1-138 at this time. Claims 1-138 have been canceled solely in order to expedite issuance of the present application. We intend to pursue the subject matter of the canceled claims in a continuing application.

#### **2. Claims 163-300 have been added**

No new matter has been added.

New claims **163-290** are directed to systems. Claims **163-290** include subject matter corresponding generally to subject matter in method claims cancelled by this Amendment (as indicated in the following table for the Examiner's convenience). Thus, we believe that new Claims **163-290** contain allowable subject matter for at least the reasons stated in this Response and in our previous response (mailed October 30, 2003). New Claims **163-290** are directed to statutory subject matter. New independent claims are in bold below.

<b>Cancelled Method Claim</b>	<b>Corresponding New System Claim</b>
1	<b>163</b>
2, 4-33, 35-86	164, 166-247 (respectively)
3 (user, user device, intermediary, and / or intermediary device)	165 (user and / or intermediary), 248 (intermediary device)
87	<b>249</b>
88	<b>250</b>
89, 90	251, 252 (respectively)
99	<b>253</b>
102	<b>256</b>
103, 104	257, 258 (respectively)
105	<b>259</b>
106-122	260-276 (respectively)
123	<b>277</b>
126	<b>278</b>
127-130	279-282 (respectively)
131	<b>283</b>
132, 133	284, 285 (respectively)
134-138	<b>286-290</b>

New Claims **291-300** are method claims. Claims **291, 295 and 300** are independent. We submit that each of new Claims **291-300** is statutory and contains allowable subject matter for at least the reasons stated herein.

## **B. Section 101 Rejection**

The present Office Action incorporates the Section 101 rejection in the Office Action mailed August 12, 2003 (Paper No. 4) and also provides additional comments in the Response to Arguments (pages 15-16).

Thus, we understand that now-cancelled Claims 1-20, 23, 25, 27, 29-33, 35-48, 50, 52, 54, 56-65, 68, 73-116, and 120-138 were rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. [Office Action, page 2]. We traverse any such rejection.

We note that the Examiner did not address any of our prior arguments against the applicability of the asserted “undue-breadth” test or “performed using a pencil and paper” test. The Examiner has not withdrawn those tests as a basis for rejection. We incorporate those arguments herein.

We note that the Examiner recognizes that each Claims 1-20, 23, 25, 27, 29-33, 35-48, 50, 52, 54, 56-65, 68, 73-116, and 120-138 has a useful, concrete and tangible result. [see Office Action, pages 15-16 (“Notwithstanding the fact that the instant invention provides a concrete, tangible, and useful result...”).]. Accordingly, we submit that the Examiner concedes that the now-cancelled claims meet the only appropriate standard for statutory subject matter under relevant case law.

We note that in the Response to Arguments the Examiner has simply asserted that a claim must be “within the technological arts.” The Examiner, however, has not explained (i) what the “technological arts” are, or (ii) how the claims fail to meet the asserted standard. Further, the cited cases do not indicate any support for the Examiner’s “undue breadth” or “performed using a pencil and paper standards.” There is no such requirement that something not be able to be performed using a pencil and paper in order to be statutory. Accordingly, the Examiner’s Section 101 rejection is arbitrary and no *prima facie* case has been established.

However, each of the claims rejected under Section 101 has been cancelled. Accordingly, the rejection is moot.

### **C. Section 103(a) Rejection**

Claims **1-162** stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,791,991 issued to Small ("Small"). We respectfully traverse the Examiner's Section 103(a) rejection.

#### **1. Prior Arguments are Not "Moot"**

On page 16, the Examiner asserts that our prior arguments are "moot" in light of the "new grounds of rejection necessitated by Applicant's demand for references in support of Official Notice." This might have been true had the Examiner provided a new reference in a proposed combination with Small.

However, the Examiner now relies on the only previously-recited reference (Small) to support all assertions of Official Notice. In our prior response, we specifically stated that Small could not support any of the Examiner's Official Notice. [see, e.g., page 33 ("Small Does Not Suggest All of the Features of All of Claims 1-162"), pages 34-36 (discussing all independent claims), pages 37 and 38 ("The cited Small reference does not support the Examiner's broad assertions as to what was well known....")]. Accordingly, the Examiner ignored our relevant arguments.

#### **2. The Examiner has Failed to Conduct the Required *Graham* Inquiries: No finding of ordinary level of skill in the art**

We have carefully reviewed the Section 103 rejections of Claims **1-162** in the present Office Action to determine compliance with the Graham requirements. We respectfully submit that the Examiner has not followed Graham with respect to any rejection under Section 103.

Specifically, the Examiner has neither

- a) defined a level of ordinary skill in the art, nor
- b) clearly indicated any evidence in support of such a finding.

Such findings are necessary in assessing obviousness. M.P.E.P. § 2141.03.

As a result of the failure to resolve and consider the level of ordinary skill, the Examiner (i) cannot have determined the scope and content of the prior art objectively, i.e., from the point of view of the hypothetical person having ordinary skill in the art at the time of invention, and thus (ii) cannot have determined the differences between the cited references and the claims objectively.

As the Examiner has failed to conduct the required Graham factual inquiries, the Examiner cannot factually support any *prima facie* conclusion of obviousness with respect to any claim. The Section 103 rejections cannot stand for at least this reason.

In any subsequent Office Action, we respectfully request that the Examiner define and submit evidence of the level of ordinary skill. Some factors that may be considered in determining the ordinary level of skill in the art are outlined at M.P.E.P. § 2141.03.

### 3. No Motivation to Modify Small

As best understood by Applicants, the Examiner asserts the following to be true with respect to all of the claims:

- a) Small teaches that each specific claimed feature not explicitly disclosed in Small would provide “a more desirable and convenient method of promoting the sale of consumer products....” (see Small col. 2, ll. 37-42)”
- b) It would have been obvious in light of (b) to modify the Small system to provide for the specific claimed features not explicitly disclosed in Small

[Office Action, pages 4-18].

The Examiner must show that the prior art of record provides the motivation of (a) above. MPEP 2143. Further, the Examiner must show that the asserted motivation of (a) above include a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art **to produce the specific features of the claimed invention**.

Applicants have carefully reviewed the Office Action issued in the present application, as well as the Small reference cited by the Examiner, without finding a motivation anywhere in the record that suggests the desirability of modifying the Small reference in any of the specific ways recited in the claims.

The Examiner relies solely on the following statement in Small for all Section 103 rejections: “It is apparent that, with recent proliferation in personal computers, the availability of on-line services and the Internet, and the increasing popularity of match games, such as Bingo and Keno, a more desirable and convenient method of promoting the sale of consumer products should be developed.” [Column 2, lines 37-43].

The Examiner does not provide any reasoning or support in the evidence of record as to why the stated general desirability of providing a “more desirable and convenient method of promoting the sale of consumer products” would suggest to one of ordinary skill in the art the desirability of providing for any specific claimed feature. Nonetheless, the Examiner relies upon this general statement alone as teaching specifically the desirability of providing for various features of all of Claims 1-162, for example, (i) *generating an unlock code capable of unlocking said outcome* and (ii) *providing an indication of said unlock code*, as recited in independent Claim 1. Applicants respectfully traverse the Examiner’s omnibus assertion.

The Examiner’s asserted motivation amounts to a mere statement by the Examiner that the proposed modifications of Small would be advantageous, and that any advantageous modification of Small would be obvious. In short, the Examiner would have found any modification to the Small system obvious if the modification provided for “a more desirable or convenient method.” This statement does not meet the requirement of evidence of a motivation in the prior art to provide for the specific claimed features. Applicants respectfully submit that the purported motivation does not suggest any such modifications of the Small system.

Applicants respectfully submit that there is no suggestion in the prior art of record to combine the particular asserted teachings of the prior art to provide for all of the features of any of the pending claims. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of any claim.

#### **4. Independent Claim 139**

##### **(a) Small Does Not Teach or Suggest All the Limitations of Independent Claim 139**

As best understood by Applicants, the Examiner believes that Small “shows” all of the features of Claim 139, including (in original FIG. 4) features of:

- *generating an unlock code associated with said outcome*
- *providing an indication of said unlock code*

[Office Action, pages 2-3, 12]. Applicants respectfully traverse this assertion. Applicants have carefully reviewed the Small reference cited by the Examiner, without finding a teaching or suggestion of any of the above features.

We do not understand how the “numbers and categories (i.e., ‘6 CEREALS’...)” in FIG. 4 of Small are understood by the Examiner to “show” or

suggest *an unlock code*, much less *generating an unlock code capable of unlocking an outcome*, much less *providing an indication of an unlock code capable of unlocking an outcome*. We respectfully submit that the depiction of a plurality of product categories that may be selected by a customer and then used in a Bingo game, as described in FIG. 4 of the Small reference, does not suggest *an unlock code capable of unlocking an outcome*.

We have previously requested that the Examiner explain his rationale and interpretation of Small. The Examiner does not provide any explanation as to how the “numbers and categories” of FIG. 4 (or any portion of Small) might suggest any such features. We request again that the Examiner explain his interpretation of the recited subject matter and the Small reference so that we might better understand the basis for rejection.

Applicants respectfully submit that Small does not disclose all of the limitations of independent Claim 139.

**(b) No Motivation to Modify Small**

As we best understand the rejection, even though the Examiner asserts that Small “shows” all of the features of independent Claim 139, the Examiner also asserts that it would have been obvious to modify the Small system in order to provide for the features listed above.

As discussed above, Small does not teach or suggest any motivation to provide specifically for those features of Claim 139. In other words, even if Small suggested the features (which we dispute), the Examiner has not provided any support of a motivation in record to modify Small to provide for all of the recited features of Claim 139 (or any claim).

**(c) Conclusion**

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 139. We submit that Claim 139 is allowable.

**5. Independent Claims 140-142**

The Examiner rejects all of independent Claims 140-142 “for substantially the same reasons” as independent Claim 139. [see Office Action, page 12]. For at least the reasons stated herein with respect to independent Claim 139, Applicants respectfully submit that the Examiner has failed to establish that Small teaches all of the limitations of any of Claims 140-142, and the Examiner has also failed to establish a motivation in the evidence of record for making the proposed modifications to the Small system.

Further, Applicants respectfully submit that Small does not teach or suggest any of the following features:

- *producing a reveal code associated with said outcome*
- *sending an indication of said reveal code*

as generally recited in each of independent Claims **140 and 142**. The Examiner has never addressed any such features. As the Examiner has ignored these limitations, the Examiner cannot have provided a *prima facie* case of obviousness of any of Claims **140 and 142**. Applicants respectfully submit that Small is devoid of a hint or suggestion of any such features, and is devoid of any suggestion of the desirability of providing for such features.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to any of independent Claims **140-142**.

## **6. Independent Claim 143**

### **(a) The Small Reference Does Not Teach or Suggest All the Limitations of Independent Claim 143**

As we best understand the rejection, the Examiner asserts that Small “shows” all of the features of Claim **143**, including (in original FIG. 4) features of:

- *providing data representative of an outcome, said outcome associated with at least one unlock code*
- *providing data representative of said at least one unlock code*

[Office Action, pages 4-5, 12]. We respectfully traverse this assertion. Applicants have carefully reviewed the Small reference cited by the Examiner, without finding a teaching or suggestion of any of the above features.

As discussed above with respect to Claim **139**, we do not understand the Examiner’s assertion that “numbers and categories (i.e., ‘6 CEREALS’...)” in FIG. 4 of Small “show” or suggest *an unlock code*. We do not agree. Accordingly, we submit that Small cannot “show” or suggest *an outcome associated with at least one unlock code*, much less *providing data representative of an unlock code*. We respectfully submit that Small does not disclose all of the limitations of independent Claim **143**.

### **(b) No Motivation to Modify Small**



As best understood by Applicants, even though the Examiner asserts that Small “shows” all of the features of independent Claim **143**, the Examiner also asserts that it would have been obvious to modify the Small system in order to provide for the above features. As discussed above with respect to Claim **139**, contrary to the Examiner’s assertion, Small does not teach or suggest any motivation to provide specifically for the features of Claim **143** (or any claim).

(c) **Conclusion**

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for independent Claim **143**. We submit that Claim **143** is allowable.

7. **Independent Claims 144-146**

The Examiner rejects all of independent Claims **144-146** “for substantially the same reasons” as independent Claim **143**. [see Office Action, pages 12-13]. Accordingly, for at least the reasons stated herein with respect to independent Claim **143**, we respectfully submit that the Examiner has failed to establish that Small teaches all of the limitations of any of Claims **144-146**, and the Examiner has also failed to establish a motivation in the evidence of record for making the proposed modifications to the Small system.

Further, Applicants respectfully submit that Small does not teach or suggest any of the following features:

- *transmitting data representative of an outcome, said outcome associated with at least one reveal code*
- *transmitting data representative of said at least one reveal code*

as generally recited in each of independent Claims **144 and 146**. The Examiner has never addressed any such features. As the Examiner has ignored these limitations, the Examiner cannot have provided a *prima facie* case of obviousness of any of Claims **144 and 146**. Applicants respectfully submit that Small is devoid of a hint or suggestion of any such features, and is devoid of any suggestion of the desirability of providing for such features.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to any of independent Claims **144-146**.

## 8. Independent Claims 147-150

The Examiner rejects all of independent Claims **147-150** “for substantially the same reasons” as independent Claim **139**. [see Office Action, pages 12-13]. For at least the reasons stated herein with respect to independent Claim **139**, Applicants respectfully submit that the Examiner has failed to establish that Small teaches all of the limitations of any of Claims **147-150**, and the Examiner has also failed to establish a motivation in the evidence of record for making the proposed modifications to the Small system.

Further, we respectfully submit that Small does not teach or suggest any of the following features:

- *associating a qualifying action with an unlock code*
- *establishing a qualifying action for an unlock code*
- *providing [or sending] an indication of said qualifying action*
- *providing [or sending] an indication of said unlock code upon a completion of said qualifying action*

Each of independent Claims **147-150** generally recites one or more of the above features. The Examiner does not assert otherwise, and has never addressed any such features. As the Examiner has ignored recited limitations, he cannot have established a *prima facie* case of obviousness of any of Claims **147-150**. We respectfully submit that Small is devoid of a hint or suggestion of any such features, and is devoid of any suggestion of the desirability of providing for such features.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to any of independent Claims **147-150**.

## 9. Independent Claims 151-154

The Examiner rejects all of independent Claims **151-154** “for substantially the same reasons” as independent Claim **139**. [see Office Action, page 14]. For at least the reasons stated herein with respect to independent Claim **139**, Applicants respectfully submit that the Examiner has failed to establish that Small teaches all of the limitations of any of Claims **151-154**, and the Examiner has also failed to establish a motivation in the evidence of record for making the proposed modifications to the Small system.

Further, we respectfully submit that Small does not teach or suggest any of the following features:

- *associating a qualifying action with an outcome*
- *establishing a qualifying action for an outcome*
- *providing [or sending] an indication of said qualifying action*
- *providing [or sending] an indication of said outcome upon a completion of said qualifying action*

Each of independent Claims **151-154** generally recites one or more of the above features. The Examiner does not assert otherwise, and has never addressed any such features. As the Examiner has ignored recited limitations, he cannot have established a *prima facie* case of obviousness of any of Claims **151-154**. We respectfully submit that Small is devoid of a hint or suggestion of any such features, and is devoid of any suggestion of the desirability of providing for such features.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to any of independent Claims **151-154**.

#### **10. Independent Claims 155-158**

The Examiner rejects all of independent Claims **155-158** “for substantially the same reasons” as independent Claim **139**. [see Office Action, pages 14-15]. For at least the reasons stated herein with respect to independent Claim **139**, Applicants respectfully submit that the Examiner has failed to establish that Small teaches all of the limitations of any of Claims **155-158**, and the Examiner has also failed to establish a motivation in the evidence of record for making the proposed modifications to the Small system.

Further, we respectfully submit that Small does not teach or suggest features generally directed to any of the following:

- *receiving [or obtaining] an indication of a qualifying action associated with an unlock code that can unlock said outcome*
- *receiving [or obtaining] said unlock code*
- *unlocking [or revealing] said outcome*

Each of independent Claims **155-158** generally recites one or more of the above features. The Examiner does not assert otherwise, and has never addressed

any such features. As the Examiner has ignored recited limitations, he cannot have established a *prima facie* case of obviousness of any of Claims **155-158**. We respectfully submit that Small is devoid of a hint or suggestion of any such features, and is devoid of any suggestion of the desirability of providing for such features.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to any of independent Claims **155-158**.

#### **11. Independent Claims 159-162**

The Examiner rejects all of independent Claims **159-162** “for substantially the same reasons” as independent Claim **139**. [see Office Action, page 15]. For at least the reasons stated herein with respect to independent Claim **139**, Applicants respectfully submit that the Examiner has failed to establish that Small teaches all of the limitations of any of Claims **159-162**, and the Examiner has also failed to establish a motivation in the evidence of record for making the proposed modifications to the Small system.

Further, we respectfully submit that Small does not teach or suggest features generally directed to any of the following:

- *receiving [or obtaining] an indication of a qualifying action associated with an outcome that can be unlocked by said unlock code*
- *unlocking [or revealing] said outcome*

Each of independent Claims **159-162** generally recites one or more of the above features. The Examiner does not assert otherwise, and has never addressed any such features. As the Examiner has ignored recited limitations, he cannot have established a *prima facie* case of obviousness of any of Claims **159-162**. We respectfully submit that Small is devoid of a hint or suggestion of any such features, and is devoid of any suggestion of the desirability of providing for such features.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness with respect to any of independent Claims **159-162**.

For at least the reasons stated above, we submit that Claims **139-162** are allowable in light of Small. We respectfully request allowance of Claims **139-162**.

**D. Newly-Added Claims 163-300 Are Patentable Over Small**

Newly-added Claims **163-300** are patentable over Small for at least the reasons presented herein.

**1. Independent Claim 163**

New independent Claim **163** is believed to be allowable for at least the reasons stated herein with respect to independent Claims **139-142** and now-cancelled independent Claim 1. The Examiner has not provided a reasoned explanation or substantial evidence of how Small teaches or suggests *an unlock code*, much less an unlock code capable of unlocking an outcome, as generally recited in new independent Claim **163**.

**2. Independent Claims 249 and 250**

New independent Claim **249 and 250** are believed to be allowable for at least the reasons stated herein with respect to independent Claims **143-146** and now-cancelled independent Claims 87 and 88. The Examiner has not provided a reasoned explanation or substantial evidence of how Small teaches or suggests *an unlock code*, much less an outcome associated with at least one unlock code, as generally recited in new independent Claims **249 and 250**.

**3. Independent Claims 253 and 256**

There is no suggestion in Small of sending an outcome to one entity and an unlock code to another entity.

New independent Claim **253** is believed to be allowable for at least the reasons stated herein with respect to now-cancelled independent Claim 99. The Examiner has not provided a reasoned explanation or substantial evidence of how Small teaches or suggests *providing an indication of a promotion outcome to a user and an indication of an unlock code associated with said promotion outcome to an intermediary*, as recited in Claim **253**.

New independent Claim **256** is believed to be allowable for at least the reasons stated herein with respect to now-cancelled independent Claim 102. The Examiner has not provided a reasoned explanation or substantial evidence of how Small teaches or suggests *providing an indication of a promotion outcome to an*

*intermediary and an indication of an unlock code associated with said promotion outcome to user, as recited in Claim 256.*

**4. Independent Claim 259**

New independent Claim **259** is believed to be allowable for at least the reasons stated herein with respect to independent Claims **147-150** and now-cancelled independent Claim 105. The Examiner has not provided a reasoned explanation or substantial evidence of how Small teaches or suggests *associating a qualifying action with an unlock code*, much less an unlock code associated with at least one outcome, as generally recited in new independent Claim **259**.

**5. Independent Claim 277**

New independent Claim **277** is believed to be allowable for at least the reasons stated herein with respect to independent Claims **151-154** and now-cancelled independent Claim 123. The Examiner has not provided a reasoned explanation or substantial evidence of how Small teaches or suggests *associating a qualifying action with an outcome*, much less an outcome associated with at least one unlock code, as generally recited in new independent Claim **277**.

**6. Independent Claim 278 and 287**

New independent Claims **278 and 287** are believed to be allowable for at least the reasons stated herein with respect to independent Claims **155-158** and now-cancelled independent Claim 126 and 135. The Examiner has not provided a reasoned explanation or substantial evidence of how Small teaches or suggests *a qualifying action associated with an unlock code*, much less an unlock code that can unlock an outcome, as generally recited in new independent Claims **278 and 287**.

**7. Independent Claims 283 and 286**

New independent Claims **283 and 286** are believed to be allowable for at least the reasons stated herein with respect to independent Claims **159-162** and now-cancelled independent Claims 131 and 134. The Examiner has not provided a reasoned explanation or substantial evidence of how Small teaches or suggests *a qualifying action associated with an outcome*, much less an outcome that can be unlocked by an unlock code, as generally recited in new independent Claims **283 and 286**.

**8. Independent Claims 288 and 289**

New independent Claims **288 and 289** are believed to be allowable for at least the reasons stated previously with respect to now-cancelled independent Claim 136 and 137. The Examiner has not provided a reasoned explanation or substantial evidence of how Small teaches or suggests *at least one qualifying action associated with at least one unlock code*, much less unlocking at least one of said at least one outcome, as generally recited in new independent Claim **288 and 289**.

**9. Independent Claim 290**

New independent Claim **290** is believed to be allowable for at least the reasons stated previously with respect to now-cancelled independent Claim 138. The Examiner has not provided a reasoned explanation or substantial evidence of how Small teaches or suggests *at least one qualifying action associated with at least one outcome*, much less unlocking at least one outcome, as generally recited in new independent Claim **290**.

**10. Dependent Claims 164-248, 251, 252, 254, 255, 257, 258, 260-276, 279-282, 284, and 285**

As we best understand the basis for rejection, the Examiner rejected all of the now-cancelled dependent claims (Claims 2-86, 89, 90, 92-98, 100, 101, 103, 104, 106-122, 127-130, 132, and 133) because Small teaches all of the features recited in each of those claims and it would have been obvious to modify Small in light the asserted motivation (discussed above). In other words, Small is relied upon as both teaching all of the features of every dependent claim and teaching a motivation to modify the Small system to provide for every claimed feature.

We respectfully traverse the Examiner's omnibus rejection of all the dependent claims that have been cancelled. The cited Small reference does not support the Examiner's broad assertion that every feature is shown or suggested in Small. The Examiner has not otherwise provided any evidence of record to support the Examiner's assertion that all such features were known.

As noted above in the table, many of the new dependent claims (Claims **164-248, 251, 252, 254, 255, 257, 258, 260-276, 279-282, 284, and 285**) correspond to or include subject matter generally found in a rejected dependent method claim that has been cancelled. Accordingly, we submit that all of the new dependent claims are allowable because the Examiner has failed to support their rejection with substantial evidence of record. Small does not disclose all of the limitations

of any of the new dependent Claims **164-248, 251, 252, 254, 255, 257, 258, 260-276, 279-282, 284, and 285**.

Some of the new dependent claims that include previously-recited subject matter that the Examiner has never addressed are discussed below.

**(a) Claims 176, 245-247 and 275**

Small does not teach or suggest invalidating a qualifying action (Claim 176), invalidating an outcome (Claim 245), invalidating an unlock code (Claim 246), invalidating a benefit (Claim 247) or invalidating at least one of an outcome, unlock code, or qualifying action (Claim 275). The Examiner has never provided substantial evidence that any such features are known or that it would be obvious to modify Small to provide for such features.

**(b) Claims 176, 245-247 and 275**

Small does not teach or suggest an expiration date, much less an expiration date associated with a qualifying action (Claims 175, 167), an outcome (Claim 217), an unlock code (Claim 218), a benefit (Claim 219) or at least one of an outcome, unlock code, or qualifying action (Claim 274). The Examiner has never provided substantial evidence that any such features are known or that it would be obvious to modify Small to provide for such features.

**(c) Claims 197, 266, 269**

Small does not teach or suggest payment for an outcome (Claim 197), for an unlock code (Claims 197, 266, 269), or for a qualifying action (Claim 269). The Examiner has never provided substantial evidence that any such features are known or that it would be obvious to modify Small to provide for such features.

**(d) Claims 221-224**

Small does not teach or suggest in which a benefit varies in relation to how many of said plurality of users unlock an outcome (Claim 221), provide a redemption request (Claim 222), or complete a qualifying action (Claims 223, 224). The Examiner has never provided substantial evidence that any such features are known or that it would be obvious to modify Small to provide for such features.

**(e) Claims 226 and 229**

Small does not teach or suggest biometric information, as recited in Claims 226 and 229. The Examiner has never provided substantial evidence that any such



features are known or that it would be obvious to modify Small to provide for such features.

**(f) No Motivation to Modify the Small Reference**

Even if all of the recited features of all of the new dependent claims were well known, which Applicants dispute, there is no suggestion or motivation in the prior art of record to modify the Small system, as proposed by the Examiner. The Examiner provides nothing beyond a mere statement that the claimed features would be advantageous. Small does not suggest why it would have been obvious to one of ordinary skill in the art to provide for any of the specific features of any of the new dependent claims. Applicants respectfully submit that there is no suggestion in the prior art of record to modify the Small system to provide for all of the features of dependent Claims 164-248, 251, 252, 254, 255, 257, 258, 260-276, 279-282, 284, and 285.

**11. Claims 291-294**

New independent Claim 291 is believed to be allowable for at least the general reasons stated herein with respect to new Claim 253 and now-cancelled independent Claim 99. The Examiner has not provided a reasoned explanation or substantial evidence of how Small teaches or suggests:

- *transmitting at least one of the plurality of locked outcomes to a device of a user*
- *transmitting at least one of the plurality of unlock codes to a merchant*

There is no hint in Small of providing a locked outcome to a user device and an unlock code to a merchant, as generally recited in new Claim 291.

With respect to Claims 292 and 293, there is no suggestion in Small of selling a locked outcome to a user or selling an unlock code to a merchant. With respect to Claim 294, there is no suggestion of receiving an indication that a locked outcome that had been transmitted to a user was unlocked.

**12. Claims 295-299**

New independent Claim 295 is believed to be allowable. There is no suggestion in Small of a merchant purchasing a plurality of unlock codes or receiving, by a device of the retailer from a device of a user, an identifier that identifies a lottery outcome that is locked, as generally recited in Claim 295.

In addition, there is no suggestion that a qualifying action comprises a user visit to an establishment of the retailer (Claim **296**), a user purchasing a product from the retailer (Claim **297**), or receiving from the user an amount for a purchase that is not less than a predetermined amount (Claim **298**). Nothing in Small suggests that a device of retailer (by which the identifier is received) comprises a point-of-sale terminal, as recited in Claim **299**.

### **13. Independent Claim 300**

New independent Claim **300** is believed to be allowable for at least the reasons stated herein with respect to now-cancelled independent Claims 1, 36 and 49. The Examiner has not provided a reasoned explanation or substantial evidence of how Small teaches or suggests *an unlock code*, much less receiving payment for an indication of an unlock code or providing an indication of an outcome to at least one user device, as generally recited in new independent Claim **300**.

For at least the reasons stated herein, we respectfully submit that new Claims **163-300** are allowable.

**E. Conclusion**

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at [mdowns@walkerdigital.com](mailto:mdowns@walkerdigital.com).

September 13, 2004  
Date

Respectfully submitted,



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